

REMARKS

Upon entry of the instant amendment, claims 1-7, 10-14 and 16-30 will remain pending in the present application.

In the instant amendment, claims 5, 13, 14 and 22 have been amended to overcome the rejections under 35 U.S.C. § 112, first and second paragraphs. Also, new claim 30 has been added.

The instant amendment made herein to the claims does not incorporate new matter into the application as originally filed. For example, the amendment to claim 13 finds support at page 1, line 22 and page 2, line 15 of the specification (i.e., the substitute specification filed on March 20, 2006) and was also amended to correct a typographical error. Claim 22 has been amended based on the disclosure at page 6, line 36 to page 7, line 4. New claim 30 is added based on claim 14.

Further, the instant amendment does not raise substantial new issues for the Examiner's consideration nor require further search on the Examiner's part. At the same time, the instant amendment puts the pending claims in condition for allowance and into a more proper format for issuance in a United States patent, by overcoming all outstanding rejections and objections of record.

Accordingly, proper consideration of each of the pending claims is respectfully requested at present, as is entry of the present amendment.

35 U.S.C. § 112, 1st Paragraph Rejection

Claims 13 and 14 have been rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement in the outstanding Office Action. (See page 2 of the Office Action.) Applicants respectfully traverse and request that the Examiner withdraw the rejection.

Claim 13

In the present amendment, claim 13 has been amended to read “The biomaterial element according to claim 1, wherein the biomaterial element contains an orthopedic material or a chemically bonded bone cement.” (Emphasis added)

The term “a chemically bonded bone cement” is supported by the disclosure, for example, at page 1, line 22 and page 2, line 15 of the specification (i.e., the substitute specification filed on March 20, 2006). Namely, a bone cement is clearly disclosed in connection with the present invention at page 1, line 22, and it is implicit therefrom that such (bone) cement can be hydrated and chemically react to form a chemically bonded biomaterial (page 2, line 15), and that such chemically bonded biomaterial can constitute a biomaterial cement. The word “orthopaedic” was corrected to fix a typographical error.

Claim 14 (and New claim 30)

Claim 14 has been amended to delete the words “or in a carrier material for drug delivery.” Thus, the rejection under 35 U.S.C. § 112, first paragraph has been overcome.

Further, regarding the feature of “a carrier material for drug delivery,” new claim 15 has been added based on the description on page 4, line 5 of the specification (i.e., the substitute specification filed on March 20, 2006).

Accordingly, upon entry of the present amendment, each of the rejections has been overcome. Applicants respectfully request that the Examiner withdraw the rejections.

35 USC § 112, 2nd Paragraph Rejection

Claims 5 and 22 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite in the outstanding Office Action.

Applicants respectfully traverse and request that the Examiner withdraw the rejection.

Claim 5

Claim 5 has been amended to delete the terms “and or” in accordance with the Examiner’s suggestion on page 3, line 1 of the Office Action. Thus, the rejection under 35 U.S.C. § 112, first paragraph has been overcome.

Claim 22

In order to further clarify the present invention, claim 22 has been amended to read “The biomaterial element according to claim 6, wherein the CaO-Al₂O₃ system contains at least one selected from (CaO)₃Al₂O₃, (CaO)₁₂(Al₂O₃)₇, CaOAl₂O₃, (CaO)(Al₂O₃)₂, (CaO)(Al₂O₃)₆, CaO, pure Al₂O₃ and a mixture thereof.” (Emphasis added)

Accordingly, upon entry of the present amendment, each of the rejections has been overcome. Applicants respectfully request that the Examiner withdraw the rejections.

Allowable Subject Matter

As stated at page 3, lines 4-8 of the Office Action, claims 1-4, 6, 7, 10-12, 16-21 and 23-29 are allowable. Further, claims 5 and 22 are allowable if rewritten or amended to overcome the rejection under 35 U.S.C. § 112, second paragraph, as discussed below.

As explained above, entry of the present amendment, the rejections of claims 5, 13, 14 and 22 have been overcome.

Provisional Request for Interview

Should the present response not place the application in condition for allowance, Applicants respectfully request a personal interview with the Examiner. The Examiner is respectfully requested to contact Toyohiko Konno (Reg. No. L0053) with regard to scheduling a personal interview with the Examiner.

CONCLUSION

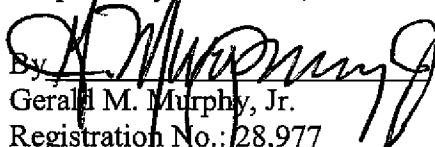
Based upon the amendments and remarks presented herein, the Examiner is respectfully requested to issue a Notice of Allowance clearly indicating that each of the pending claims are allowed.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Toyohiko Konno (Reg. No. L0053) at the telephone number below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Dated: AUG 25 2008

Respectfully submitted,

By: 

Gerald M. Murphy, Jr.

Registration No.: 28,977

BIRCH, STEWART, KOLASCH & BIRCH, LLP

8110 Gatehouse Road

Suite 100 East

P.O. Box 747

Falls Church, Virginia 22040-0747

(703) 205-8000

Attorney for Applicant